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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,618	12/18/2000	James M. Barton	60097-0195	9889
29989 7590 09/15/2009 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110				
EXAMINER SHELEHEDA, JAMES R				
ART UNIT		PAPER NUMBER		
2424				
MAIL DATE		DELIVERY MODE		
09/15/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/740,618

**Applicant(s)**

BARTON, JAMES M.

**Examiner**

JAMES SHELEHEDA

**Art Unit**

2424

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16, 18, 40 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 18, 40 and 42-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/10/09 has been entered.

### ***Response to Arguments***

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16, 18, 40 and 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balakrishnan et al. (Balakrishnan) (6,473,903) (of record) in view of Haddad (6,072,982) (of record) and Nagasaka et al. (Nagasaka) (5,974,218).

As to claims 16, 42 and 45, Balakrishnan discloses a method, and corresponding apparatus and computer readable medium (column 3, lines 20-39), for enhancing viewership of television advertisements (column 3, lines 20-38), comprising:

one or more processors (column 3, lines 20-39 and column 1, line 64-column 2, line 9);

receiving, by a digital video receiver, a program segment containing a commercial break (receiving a "main program"; Fig. 1; column 3, lines 20-38);

playing the program segment to a viewer (column 3, lines 20-38);

detecting, by the receiver, an in band signal associated with the program segment, the in band signal containing information about each of the commercials in the commercial break (menu to display ad logos; Fig. 1; column 3, line 40-column 4, line 9);

in response to detecting the in band signal:

creating, by the receiver, a menu based on the information contained in the in band signal about each of the commercials in the commercial break (column 3, line 40-column 4, line 9); and

displaying the menu (column 3, line 40-column 4, line 9).

While Balakrishnan discloses while displaying the menu, allowing the user to select a particular item in the menu (column 3, line 40-column 4, line 9), he fails to specifically disclose while displaying the menu, pausing playback of the program segment by the DVR and the user is allowed to select between skipping past the menu to continue viewing the program segment and selecting a particular item in the menu.

In an analogous art, Haddad a television distribution system (Fig. 3) which will utilize a DVR to pause playback of the broadcast program while a menu is displayed on the screen (column 12, lines 44-56 and column 14, lines 15-26) until the viewer is finished browsing the menu selections (column 12, lines 44-56) for the typical benefit of ensuring that the viewer take as long as they need to browse and make a selection from the menu without missing any of the program (column 12, lines 44-56).

Additionally, in an analogous art, Nagasaka a video distribution system (column 1, lines 19-29) where the video recorder will generate a menu for the user to allow selection of a particular commercial within the program or to skip past the commercial break to continue viewing the program (Fig. 5; column 18, lines 10-25) for the typical benefit of providing a user friendly means to easily skip past unwanted video portions, such as those of commercial intervals (column 18, lines 10-25).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Balakrishnan's system to include a DVR pausing playback of the program segment, while displaying the menu, as taught in combination with Haddad, for the typical benefit of allowing a viewer browse a menu as desired and return to the program without missing anything.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Balakrishnan and Haddad's system to include and the user is allowed to select between skipping past the menu to continue viewing the program segment and selecting a particular item in the menu, as taught in combination

with Nagasaka, for the typical benefit of providing a user friendly means to easily skip past unwanted video portions, such as those of commercial intervals.

As to claims 18, 43 and 46, Balakrishnan, Haddad and Nagasaka disclose wherein the in band signal comprises a tag that triggers the DVR to display the menu and wherein the tag includes information to be displayed in the menu (Balakrishnan at column 3, lines 40-56 and Fig. 1).

As to claims 40, 44 and 47, Balakrishnan, Haddad and Nagasaka disclose wherein the pausing step is triggered by the DVR upon detection of an in band signal (see Balakrishnan at column 3, lines 40-56 and Fig. 1 and Haddad at column 12, lines 44-56 and column 14, lines 44-56).

### ***Conclusion***

5. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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### **Certificate of Transmission**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. ( ) \_\_\_\_\_ - \_\_\_\_\_ on \_\_\_\_\_.  
(Date)

Typed or printed name of person signing this certificate:

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Signature: \_\_\_\_\_

Registration Number: \_\_\_\_\_

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/  
Primary Examiner, Art Unit 2424

JS